

***Rejections under 35 U.S.C. §102(e)***

At paragraph 5 of the Office Action, the Examiner rejected claims 12-45 as being anticipated by U.S. Patent No. 5,448,705 to Nguyen *et al.* (hereinafter Nguyen). As set forth below, Applicants submit that Nguyen is not prior art under 35 U.S.C. § 102(e) because "one's own invention whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar." *In re Facius*, 408 F.2d 1396, 1406.

First, Applicants note that the inventors in both the present application and the Nguyen reference were included as part of the S-MOS "Seabird" project team. The S-MOS "Seabird" project team produced the microprocessor architecture that is described in the Nguyen reference. The Nguyen reference describes and claims in part a method of operation in the overall "Seabird" microprocessor architecture.

As part of the "Seabird" project team, Applicants were responsible for the design of the Instruction Execution Unit (IEU). The Applicants' IEU design is described generally in the Nguyen reference. The present application further describes the IEU initially disclosed in Nguyen in greater detail to support the invention as claimed in the present application. Thus, the IEU disclosed in the Nguyen reference is derived from the Applicants rather than the inventors listed on the Nguyen reference. The supporting declarations filed herewith set forth the facts as detailed above.<sup>1</sup> Applicants submit that these declarations provide a "satisfactory showing which would lead to a reasonable conclusion" that Applicants are the inventors of the claimed subject matter. See MPEP § 716.10 and *In re Katz*, 687 F.2d 450,

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<sup>1</sup> Filed herewith are true copies of original, signed declarations of Kevin Iadonato, Le Nguyen and Sanjiv Garg, which were filed in Appl. No. 08/594,401, now U.S. Patent No. 5,737,624. The declaration of the remaining inventor, Johannes Wang, has not yet been returned.

455, 215 USPQ 14, 18 (CCPA 1982). For these reasons, Applicants request that the outstanding rejection of claims 12-30 be withdrawn.

***Rejections under the judicially created doctrine of obvious-type double patenting***

At paragraph 3 of the Office Action, the Examiner rejected claims 12-45 under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,497,499 to Garg *et al.* Similarly, at paragraph 4 of the Office Action, the Examiner rejected claims 12-45 under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,737,624 to Garg *et al.* Applicants obviate the obviousness-type double patenting rejections based upon the terminal disclaimer submitted herewith. Please note that the assignment by the inventors to S-MOS Systems, Inc. was filed in Appl. No. 07/860,719. U.S. Patent No. 5,497,499 issued from Appl. No. 08/219,425, which is a continuation of Appl. No. 07/860,719. Similarly, U.S. Patent No. 5,737,624 issued from Appl. No. 08/594,401, which is a continuation of Appl. No. 08/219,425.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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